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IN THE

Supreme Court of the United States

OCTOBER TERM 1943

ERNEST WALKER SAWYER,

Petitioner,

against

CROWELL PUBLISHING COMPANY

Respondent.

PETITION FOR WRIT OF CERTIORARI

HERBERT GOLDMARK,
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PETITION FOR WRIT OF CERTIORARI

To the Honorable, the Chief Justice of the United States and the Associated Justices of the Supreme Court of the United States:

Ernest Walker Sawyer prays for a writ of certiorari to review the decree of the United States Circuit Court of Appeals for the Second Circuit entered on the 19th day of May, 1944, affirming the judgment of the District Court of the United States for the Southern District of New York entered on May 13th, 1942 dismissing the bill of complaint herein.

Summary Statement of the Matter Involved

This action was brought under the Act of March 4th, 1909, 35 U. S. Statutes at Large 1075, Chap. 320, U. S. C. A. Title 17, subdivision (b) of Section 5 for the infringement of copyright of a map (R., pp. 2-4).

Petitioner, who is a civil engineer, radio engineer and electrical engineer (R., p. 17) was appointed in 1929 the executive assistant to Mr. Ray Wilbur, Secretary of the Interior (R., p. 21). A few months after his appointment he was informed by Mr. Wilbur that in Alaska a dangerous situation had developed for the Administration and for everyone, in that the white men were stealing the reindeer of the Eskimos and the Eskimos were shooting the white men. Mr. Wilbur asked petitioner to make a trip to Nome, Alaska, to find out what the situation was (R., p. 67).

Petitioner made this trip to Alaska. While there, he made many airplane flights. One of these flights was over Fairbanks, Alaska, which is 7000 ft. to 8000 ft. above sea level (R., p. 67).

Petitioner had made a study of the transmission of radio waves, particularly over land and sea, and found that there was great resistance to radio waves over land and over deserts, which required heavier power to get through than was required over water and he had been constantly working on the idea of a central station for the transmission of radio waves, such as exists for telephone service (R., p. 21).

Accordingly when he flew over Fairbanks he realized that it was the ideal spot for such a central station, because from Fairbanks it would be easy for the radio waves to go over water, namely, over Bering Sea, the Arctic Ocean and the South Pacific to London, Tokio, New York and other big cities, which were within 5000 miles of Fairbanks and which did 80% of the business of the world (R., pp. 24, 40).

When petitioner returned to Washington in the fall of 1929 he made his report to the Secretary of the Interior (R., p. 49).

It is uncontradicted that no map accompanied that report (R., p. 49).

Petitioner, however, in pursuance of his idea to make a map with Fairbanks as the center, called upon the National Geographic Magazine, on the Navy Department and the U. S. Geological Survey to obtain a "Great Circle" map (R., pp. 24-26).

The distance by the "Great Circle" is the shortest distance on the surface of the earth between two given points (R., pp. 25, 78).

In none of those places could petitioner obtain a suitable Great Circle map. The librarian and expert map makers in the Geological Survey told petitioner that his idea was ridiculous and that he could not produce a map such as he had described (R., p. 10).

Petitioner found that he was unable by himself to work out the distances between those different cities by means of a slide rule and to make a map himself (R., p. 26).

He was recommended to the Land Office, where he was introduced to a man named Wills, a draftsman (R., p. 26).

In three weeks Wills gave petitioner the distances and directions and petitioner plotted them on a piece of paper and Wills then checked 15 cities on the map (R., p. 10). After 10 months the map, Plaintiff's Exhibit I, was produced (R., p. 28 and Opposite R., p. 126).

It is important to note here that the District Court in its opinion found that both petitioner and Wills worked on the details of the map "Wills doing most of the physical work" (R., p. 141).

This map was copyrighted on April 22nd, 1930 (R., p. 132). The map was republished on February 1st, 1931 (R., pp. 52 and 74) and is, in evidence as Defendant's Exhibit B (R., p. 74 and opposite R., p. 136).

The only difference between the copyrighted map and the republished map is that in the latter there are approximately eleven red lines and figures showing the

mileage distances between Fairbanks and 9 other cities, which do not appear on the copyrighted map and also that in the republished map the words "and terminus of the Pacific-Yukon Highway" were added to the title (R., pp. 52, 74 and 157). This additional matter was not copyrighted by the petitioner (R., p. 52).

On this republished may, known as Map No. 8 (R., p. 136), the words were printed "This map was originated and produced by Ernest Walker Sawyer. Republished February 1st, 1931 by permission by the the Commissioners appointed for a study regarding the construction of a highway to connect the northwestern part of the United States with British Columbia, Yukon Territory, and Alaska" and was signed by the three Commissioners, of whom petitioner was one (R., pp. 30, 31, 159).

It also appeared that this Map No. 8 is represented to be a Department of Interior publication in a booklet published by said department about June 1931 (R., p. 55 and Defendant's Exhibit D, opposite R., p. 138).

The evidence was uncontradicted that prior to petitioner's map, there was no map in existence using Fairbanks as such center and leading to such principal cities.

In fact, the Circuit Court of Appeals said in its opinion:

> "We shall assume, as the appellant argues, that the choosing of Fairbanks as the focal center from which to plot directions within the great circle to other cities was an original and novel feature which would have made the 1930 map copyrightable by him, if he had not been in the employment of the United States."

The Circuit Court of Appeals affirmed the findings of the District Court that not only did petitioner hold the map in trust for the United States, but that said map became a Government publication, because it was republished by the Government as Map 8 and incorporated later in a Government pamphlet.

In view of this holding the Court stated in the last sentence of its opinion that it was not necessary to consider whether the defendant's map (Plaintiff's Exhibit 2, opposite R., p. 128), amounted to an infringement.

Jurisdiction

Jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13th, 1925.

Questions Presented

1. Whether the Circuit Court of Appeals did not err in failing to apply to the facts in this case the rule laid down in *United States* v. *Dubilier Condenser Co.*, 289 U. S. 178.

Petitioner contends that if said decision had been correctly applied, the Circuit Court of Appeals would have reached the conclusion that, since the petitioner's trip to Alaska was in pursuance of his general employment as executive assistant to the Secretary of the Interior and he was not specifically employed to make this map, the mere fact that the map was found to have been made to accompany a report of said trip, thus undertaken, was not sufficient to constitute petitioner a trustee of said map for the United States.

2. Whether the Circuit Court of Appeals did not err in considering the publication of Defendant's Exhibits B and D, as evidence that the map was held in trust for the Government, rather than a mere license by the petitioner, running only to the Government, to publish his copyrighted map, in accordance with Section 7 of the Copyright Act.

Reasons Relied on for Allowance of the Writ

1. The Writ should be granted, because the decision of the Circuit Court of Appeals is upon an important question of federal law and is in conflict with the decision of this Court in *U. S.* v. *Dubilier Condenser Corporation*, 289 U. S. 178. This is a sufficient ground for granting the writ.

> *Douglas* v. *Cunningham*, 294 U. S. 207;
> *Magnolia Petroleum Co.* v. *Hunt*, 320 U. S. 430, 434;
> *Walton* v. *Southern Package Corp.*, 320 U. S. 540, 541.

The importance of the question appears from the fact that if the decision of the Circuit Court of Appeals is not reversed, then any employe of the Government, who, in the course of a very general employment makes an invention or prepares the material which is the subject of a copyright, is deemed to lose title to the invention or the copyrighted matter.

Such a conclusion would stifle every attempt of a person employed by the Government to give something of value to the community, for it would remove all incentive to creative effort by depriving the employe of the fruits of his work, not only as against the Government, but as against the whole world.

2. The Writ should be granted because the Circuit Court of Appeals ignored the provision of Section 7 of the Copyright Act, quoted above, which provides that "the publication or republication by the Government in any public document of any material in which copyright is subsisting shall not cause any abridgment or annulment of the copyright, or authorize any use or appropriation

of such copyright material without the consent of the copyright proprietor".

Although stress was laid upon this paragraph in the brief of petitioner in the Circuit Court of Appeals, it was ignored in the opinion of that Court.

Petitioner contends that under the above provision the publication by the Government of the copyrighted map as Map No. 8 (Defendant's Exhibit B) and as a part of Defendant's Exhibit D, which was a Government publication (R., p. 138), did not authorize the infringement of the copyright by the defendant.

The above provision has never been construed by any Court, as far as petitioner has been able to discover. It is important that it should be interpreted to determine the rights of copyright owners. Where the question involved is one of importance in the administration of a Federal statute a sufficient ground has been established for granting the writ.

Roberts v. *U. S.*, 320 U. S. 264, 265;
S. E. C. v. *Joiner Corp.*, 320 U. S. 344, 345;
Commissioner v. *Gooch Co.*, 320 U. S. 418, 419;
Falbo v. *U. S.*, 320 U. S. 549, 551.

POINT I

The Court erred in failing to hold that under the rule laid down in *U. S.* v. *Dubilier Condenser Co.*, 289 U. S. 178 petitioner did not hold the map in trust for the Government.

In its opinion (R., p. 158) the Circuit Court of Appeals said:

> "We shall assume, as the appellant argues, that the choosing of Fairbanks as the focal center from which to plot directions within the great circle to other

> cities was an original and novel feature which would have made the 1930 map copyrightable by him, if he had not been in the employment of the United States (See General Drafting Co. v. Andrews, 37 F. 2d, 54, 55 (CCA 2); Freedman v. Milnag Leasing Corp., 20 F. Supp. 802, 803 (S. D. N. Y.); Woodman v. Lydiard-Peterson, 192 F. 67, 69 (CC Minn), aff'd 204 F. 921 CCA 8)".

There was no dispute that petitioner was appointed executive assistant to the Secretary of the Interior in March 1929 and remained such until 1933 (R., pp. 47, 48) and that it was in that capacity that he was sent to Alaska to investigate the reindeer situation which had become dangerous to the Administration, because the white men were stealing the deer of the Eskimos and the latter were shooting the white men (R., p. 23).

It is true that petitioner also testified, as stated by the Circuit Court of Appeals (R., p. 159) that he went to Alaska "to make a survey of the facilities that were there under the Department of the Interior (R., p. 48) and that defendant's witness Wills testified, as also stated (R., p. 159) by the Circuit Court of Appeals, that petitioner told him that he wanted the map "in connection with his work in Alaska to point out the availability of Fairbanks, Alaska, as a logical site for the location of radio stations and aviation fields and for use in connection with his report to the Secretary of the Interior" (R., p. 80).

However, petitioner also testified without contradiction that he was not specifically employed to design any map of Alaska (R., p. 44) and there is not a scintilla of evidence in the record to disprove this statement.

It is further undisputed that the map did not accompany petitioner's report to the Secretary of the Interior which was made in the fall of 1929 (R., p. 49). In fact the map was not completed until about April 1930 (R., pp. 83, 134). If the map was intended to be a part of the re-

port, as claimed by the defendant, why did not petitioner go immediately to the Department of the Interior for assistance in preparing the map, rather than as a last resort, after he had visited the National Geographic Magazine, the Navy Department and the U. S. Geological Survey?

Furthermore there is no testimony in the record that the map was germane to the report, because the report was not offered in evidence, but on this point the Circuit Court of Appeals says that "without a knowledge of its contents we cannot assume that the map was not germane to the report".

While we believe that it is immaterial whether the map was germane to the report, the burden was on the defendant, in any event, to show that the map was an integral part of the report.

However, the salient fact is that the trip to Alaska was undertaken only in pursuance of petitioner's general employment as Executive Assistant to the Secretary of the Interior and that the uncontradicted evidence is that petitioner was not specifically employed to make this map, which formed at the most a minor feature of petitioner's report of this trip.

Under this state of facts the language of this Court in

U. S. v. *Dubilier Condenser Co.*, 289 U. S. 178

makes the conclusion inevitable that the petitioner did not hold the copyrighted map in trust for the United States.

This Court said at page 187:

> "One employed to make an invention, who succeeds during his term of service, in accomplishing that task, is bound to assign to his employer any patent obtained. The reason is that he has only produced that which he was employed to invent. His invention is

> the precise subject of the contract of employment. A term of the agreement necessarily is that what he is paid to produce belongs to his paymaster. Standard Parts Co. v. Peck, 264 U. S. 52. On the other hand, if the employment be general, albeit it cover a field of labor and effort in the performance of which the employee conceived the invention for which he obtained a patent, the contract is not so broadly construed as to require an assignment of the patent. Hapgood v. Hewitt, 119 U. S. 226; Dalzell v. Dueber Watch Case Mfg. Co., 149 U. S. 315".

It is clear, we submit, that the Circuit Court of Appeals erred in failing to hold that under the decision in *U. S.* v. *Dubilier* (*supra*) petitioner's copyright was valid.

The Circuit Court of Appeals held that the case at bar was governed by the decision in

> *U. S. Ozone* v. *United States Ozone Co.*, 62 F. (2d) 881 (CCA 7th).

That case was decided before *U. S.* v. *Dubilier Condenser Co.* (*supra*), and is not in point here.

In that case it was shown that the inventor was specifically instructed by his employer to prepare the material contained in the copyrighted work.

In the case at bar, as pointed out above, not only was the petitioner not specifically employed to make this map, but the trip to Alaska itself, as a result of which petitioner made the map, was only an incident to petitioner's general employment as Executive Assistant to the Secretary of the Interior.

POINT II

The republication by the Department of the Interior of the copyrighted map and the inclusion of said map in a Government publication did not give defendant the right to use the map.

The Circuit Court of Appeals in discussing whether the map must be deemed to have been held in trust by the petitioner for the Government, said, in referring to the republished map (Map No. 8) (R., p. 157):

> "When completed Map No. 8 was engraved and printed by the United States Geological Survey, a bureau of the Department of the Interior",

and again at page 159 the Court said:

> "Moreover, it is not without significance, we think that Mr. Sawyer never made any commercial use of the map and permitted it to be republished as an official document of the Department of the Interior."

At page 157 the Court stated:

> "In an official publication of the Department entitled General Information regarding the Territory of Alaska, Map No. 8 is represented to be a Department of the Interior publication relating to Alaska."

This publication is Defendant's Exhibit D.

In stating that petitioner permitted the copyrighted map to be republished as an official document of the Department of the Interior, as bearing on the question whether the copyrighted map was held in trust for the Government, the Court overlooked the legend on the republished map, to which it refers in another part of its opinion (R., p. 157), that the map was "Republished February 1st, 1931 by permission by the Commissioners appointed for a study regarding the construction of a highway to connect

the northwestern part of the United States with British Columbia, Yukon Territory, and Alaska". It also ignored the fact that on said republished map, preceding the above quotation were the words: "This map was originated and produced by Ernest Walker Sawyer".

The fact that the Department of the Interior permitted said words to be inserted on the map and that the map was stated to be republished by permission (meaning, necessarily, the permission of the petitioner) far from being any evidence that petitioner regarded his map as a Government publication, was, on the other hand, a recognition by the Government that petitioner had a valid copyright.

Furthermore, petitioner by giving such consent to the republication of his copyrighted map by the Government, added nothing to the right which the Government had, without such consent, to republish said map.

The Circuit Court of Appeals in reaching the conclusion that the republication of the map by the Department of the Interior as Map 8 (Defendant's Exhibit B) and the inclusion of the copyrighted map as a part of an official publication of said department (Defendant's Exhibit D) was evidence that petitioner considered that he held the map in trust for the Government, ignored the following paragraph in Section 7 of the Copyright Act (17 U. S. C. A).

This paragraph reads as follows:

> "The publication or republication by the Government, either separately or in a public document of any material in which copyright is subsisting shall not be taken to cause any abridgment or annulment of the copyright or to authorize any use or appropriation of such copyright material without the consent of the copyright proprietor."

Stress was laid on the importance of the above provision in the brief of petitioner before the Circuit Court of

Appeals, but no mention of it was made by said Court in its opinion. Said provision has never been passed upon by any Court, as far as we have been able to discover, and for that reason, on account of its applicability to all copyrighted material, we think that this Court should interpret the same.

The reason for the passage of said part of Section 7 is stated in 13 Corpus Juris, Title "Copyright and Literary Property" Sec. 125 note 15 (a), as follows:

> "Section 7 was inserted for the reason that the Government often desires to make use in its publications of copyrighted material with the consent of the owner of the copyright, and it has been regarded heretofore as necessary to pass a special act every time this was done, providing that such use by the Government should not be taken to give to anyone the right to use the copyrighted material found in the Government publication. It was thought best, instead of being obliged to resort every little while to a special act, to have some general legislation on this subject" (Report of Committee on Patents to House of Representatives, Jan. 30, 1907 No. 7083, p. 10).

Now under this provision it was really not necessary for the Department of the Interior to have obtained the consent of the petitioner to the republication of the copyrighted map, for even without such consent, such republication could not give any one else, such as the defendant, the right to use the copyrighted map.

Possibly the permission of petitioner was given to said Department in an excess of caution.

In any event, the Circuit Court of Appeals, we submit, should have considered the evidence as to whether petitioner held the map in trust for the Government without reference to said republication, and, if he did not, should have reached the conclusion that such republication did not invalidate petitioner's copyright.

The same argument applies to Exhibit D. The Circuit Court of Appeals does not say that petitioner ever consented to the inclusion of his copyrighted map as a part of this Government publication.

Likewise, under the above quoted paragraph in said Section 7, the use of petitioner's map in this publication could not deprive him of his copyright if it otherwise was valid against the Government.

All that Section 7 gave to the Government was a license to use said copyrighted material, but the defendant did not thereby acquire any right to such use.

CONCLUSION

The petition for a writ of certiorari should be granted.

HERBERT GOLDMARK,
Counsel for Petitioner.

August 15th, 1944.